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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/779,317 | 02/08/2001 | Tsuguhide Sakata | 1232-4681 | 4553 |

7590 03/17/2004
MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, NY 10154

EXAMINER

ENG, GEORGE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2643

16

DATE MAILED: 03/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,317

Applicant(s)

SAKATA, TSUGUHIDE

Examiner

George Eng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/20/2004 (paper no. 14) has been entered.

Response to Amendment

2. This Office action is in response to the amendment filed 2/20/2004 (paper no. 15).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 7-10 and 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clapp et al. (US PAT. 6,073,192 hereinafter Clapp) and Rodriguez et al. (US PAT. 5,999,207 hereinafter Rodriguez).

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Regarding claim 1, Clapp discloses a communication device (242, figure 7) for communicating in video and audio with another terminal device (262, figure 7) comprising an external connection interface (142, figure 5) for connecting with an external data processor (72, figure 5), communication means (170, figure 5) for exchanging information with the other terminal device, video input means (78, figure 5), video output means (76, figure 5), audio input means (80, figure 5), audio output means (220, figure 5), and control means (200, figure 5) for controlling an operation (col. 8 line 17 through col. 19 line 34). Note while Clapp teaches the communication device capable of providing stand-alone video conferencing capability to output video data to be displayed to the video output means in accordance with an operation, i.e., a first operation mode (col. 7 lines 17-29), and to transfer video data to be display to the external processor (72) in accordance with control commands received from the external data processor through the external connection interface, i.e., a second operation mode, when the communication device is coupled to the external processor (col. 7 lines 30-49) so that Clapp obviously includes mode-setting means for setting the first operation mode for unassisted operation or the second operation mode for operation under the control of the external processor and mode selecting means for automatically selecting between the first operation mode when the communication device is not connected with the external processor and the second operation mode when the communication device is connected with the external processor. Thus, the communication device is capable of automatically selecting either in the first operation mode for unassisted operation or in the second operation mode for operation under the control of an external data processor depending upon the communication device being connected with the external data processor or not. In addition, Clapp clearly teaches control commands, i.e.,

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instructions, being generated by application software running in the external data processor (72, figure 5) during the second operation mode (col. 7 lines 30-65), and the communication device providing stand-alone video capability when it is not connected to the external data processor, (col. 7 lines 17-29) so that one skill in the art would recognizes the communication device of Clapp transiting to the stand-alone video capability, i.e., first operation modem, when the external data processor is disconnected or the application running in the external data processor is terminated. Clapp differs from the claimed invention in not specifically teaching the communication comprising operation means. However, it is notoriously well known in the art of a stand-alone video communication device comprising operation means in order to allow a user to access video communication functionalities with an input control device, for example see Rodriguez (abstract and col. 1 line 66 through col. 2 line 67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Clapp in having the operation means in the stand-alone communication device, as per teaching of Rodriguez, because it makes user friendly so that it allows the user to access video communication functionalities with the input control device.

Regarding claims 2-3, Clapp teaches the communication device provides stand-alone video conferencing capability such that the communication device is automatically operating in the first operation mode after power is supplied (col. 7 lines 17-29 and col. 16 lines 19-50), and the communication device is operating in the second operation mode in accordance with a control instruction with the external processor when the communication device is coupled with the external processor (col. 7 lines 30-49 and col. 16 lines 51-66). Thus, it recognizes the mode

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setting means set the first operation mode in response to the connection state with the external processor changing to a substantially disconnected state.

Regarding claim 4, Clapp teaches the communication device capable of operating in accordance with a control signal control from the external processor (col. 7 lines 30-35).

Regarding claim 7, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claims 8-9, the limitations of the claims are rejected as the same reasons set forth in claims 2-3.

Regarding claim 10, the limitations of the claim are rejected as the same reasons set forth in claim 4.

Regarding claims 13-19, the limitations of the claims are rejected as the same reasons set forth in claim 1.

5. Claims 5-6 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clapp et al. (US PAT. 6,073,192 hereinafter Clapp) and Rodriguez et al. (US PAT. 5,999,207 hereinafter Rodriguez) as applied in claims above, and further in view of Kato et al. (US PAT. 5,898,824 hereinafter Kato).

Regarding claims 5-6, Clapp teaches the communication device comprising a recording medium (col. 8 line 25). The combination of Clapp and Rodriguez differs from the claimed invention in not specifically teaching recording management means for recording data to be recording in the external data processor when the recording medium has its space area less than a predetermined amount, and recording management information indicating that the data is

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recorded in the external processor on the recording medium, wherein the management means checks on the basis of the management information as to whether or not data to be reproduced exists in the recording medium and reproduces the data when it exists in the recording medium and request the external data processor to transfer the data when it exists in the external data processor. However, Kato teaches a method for improve a storage capacity of a communication device, i.e., a facsimile device, connected with a computer comprising detecting means, i.e., management means, for checking a residual amount of storage capacity of a first storage in the communication device, selecting a second storage in the computer for storing data when detecting means detecting that the first storage has it space area less than a predetermined amount, and means for determining whether the data is stored in the first storage or the second storage in order to reproduce the data being stored in the second storage when it exists in the computer (col. 10 line 50 through col. 14 line 67) so that it recognizes the detecting means recording management information indicating that the data is recorded in either the communication device or the computer. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Clapp and Rodriguez in having the management means, as per teaching of Kato, because it improves the storage capacity of the communication device.

Regarding claims 11-12, the limitations of the claims are rejected as the same reasons set forth in claims 5-6.

Response to Arguments

6. Applicant's arguments filed 2/20/2004 (paper no. 15) have been fully considered but they are not persuasive.

In response to applicant's argument that either individually or in combinations of Clapp, Rodriguez and Kato fail to teach or suggest the newly claimed features of the present invention, Clapp clearly teaches control commands, i.e., instructions, being generated by application software running in the external data processor (72, figure 5) during the second operation mode (col. 7 lines 30-65), and the communication device providing stand-alone video capability when it is not connected to the external data processor, (col. 7 lines 17-29) so that one skill in the art would recognize the communication device of Clapp transiting to the stand-alone video capability, i.e., first operation mode, when the external data processor is disconnected or the application running in the external data processor is terminated. Note the claimed language does not specifically mention the system being automatically switch back and forth between the different modes. Thus, Clapp, as well as the combination of Clapp and Rodriguez, is enough to reject the broad claimed limitations.

Conclusion

7. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114.

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See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 872-9306 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is (703) 308-9555. The examiner can normally be reached on Tuesday to Friday from 7 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

A handwritten signature in black ink, appearing to read "George Eng". The signature is fluid and cursive, with the first name "George" and the last name "Eng" clearly distinguishable.

George Eng
Primary Examiner
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